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| 10/576,965 | 04/25/2006 | Hidekazu Hoshino | 127846 | 2790 |
| 25944 7590 09/16/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | | |
| EXAMINER KILPATRICK, BRYAN T | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,965

Applicant(s)

HOSHINO ET AL.

Examiner

BRYAN T. KILPATRICK

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 25 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-859)
Paper No(s)/Mail Date 04/25/2006 and 08/31/2007
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

DETAILED ACTION

Summary

1. This is the initial Office action based on the application 10/576,965 PCT filed October 27, 2004.
2. Claims 1-11 are pending and have been fully considered.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4, and 6-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6-7, 11, and 24 of U.S. Patent No. 7,388,627 (HOSHINO et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Instant claim 1 recites a discrimination medium comprised of a cholesteric liquid crystal layer having circular polarization light selectivity of reflecting predetermined circularly polarized light, and a multilayer film having plural light transparent films that are laminated and are different from each other in refraction index. HOSHINO et al. recites in the same limitations in claim 1.

Instant claim 4 requires a discrimination medium with a figure to be provided to at least a portion of either the cholesteric liquid crystal layer or multilayer film; HOSHINO et al. recites a discrimination medium with an optical functional layer that has a figure in claim 7. Instant claim 6 requires a discrimination medium with an interlayer peeling structure or a peeling breaking structure; HOSHINO et al. recites a discrimination medium with a structure in which interlayer peeling easily occurs in claim 6. Instant claim 7 requires an article to be discriminated

comprised of a discrimination medium with the limitations of instant claim 1.

HOSHINO et al. recites in claims 11 and 24 the same limitation. Instant claims 8-11 state a discrimination medium with a cholesteric liquid crystal layer having a circular polarization light selectivity of reflecting predetermined circularly polarized light, and a multilayer film having plural light transparent films that are laminated and are different from each other in refraction index. HOSHINO et al. states this same limitation in claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being obvious over European Patent 1,028,359 A1 (SHIOZAWA et al.).

Instant claim 1 recites a discrimination medium comprising a cholesteric liquid crystal layer and a multilayer film. Instant claims 2 and 3 require reflections of light off the cholesteric liquid crystal layer and multilayer film; approximately equal to each other in color for instant claim 2 and different from each other in color for instant claim 3, respectively. SHIOZAWA et al. discloses circular polarized light selectivity in the Abstract, and paragraphs [0030]-[0041] disclose the use of cholesteric liquid layers and films having multiple layers. Also, SHIOZAWA et al. discloses a method of producing a hologram (which the prior art defines as a pattern, image, or characters in the first line of paragraph [0062]) on an authenticity identifying film comprised of multiple layers: a reflective film (which has a cholesteric liquid crystal layer or phase), a protective film, a light absorbing film, and a base film in paragraphs [0046]-[0057]. SHIOZAWA et al. is from the field of endeavor of authenticity identification. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the method of authenticity identifying via colors since it was known in the art of a method of authenticity identifying via a hologram. The motivation would have been to provide an authenticity identifying film having a highly esthetic design and facilitating visual authenticity identification, as disclosed in paragraph [0007]. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Instant claim 4 requires a figure to be provided to at least a portion of one of the layer and film. Instant claim 5 requires hologram working or embossing. Instant claim 6 requires interlayer peeling structure or a peeling breaking structure. Instant claim 7 requires an article to be discriminated having the discrimination medium. Paragraph [0003] of SHIOZAWA et al. discloses the use of characters and patterns similar to the figures and characters stated by the current instant specification in paragraph [0003]. Paragraphs [0012]-[0013] of SHIOZAWA et al. disclose an embossed hologram and an authenticity identifying film attached to an article via an adhesive layer. Paragraph [0099] of SHIOZAWA et al. discloses the use of a form of peeling breaking for preventing the reuse of a discrimination medium.

Instant claims 8-11 disclose the use of the discrimination medium comprised of layers and films being analyzed by a device having an optical filter, a light irradiation device, and a light detector. The Abstract, paragraphs [0019]-[0022], and [0085]-[0091] of SHIOZAWA et al. disclose the use of these type of components in a system for authenticity identification.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 4,761,543 (HAYDEN) discloses a device for reading

materials for authenticity in the Abstract. U.S. Patent Application 2002/0051264 A1 (SHIOZAWA et al.) discloses an authenticity identifying film in the Abstract.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN T. KILPATRICK whose telephone number is (571)270-5553. The examiner can normally be reached on Mon - Fri (alt Fri off); 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.